

REMARKS

The last Office Action of September 10, 2007 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-10 are pending in the application. No amendment has been made.

In order to perfect the claim of priority, applicant submits herewith a translation of the German priority documents 102 37 446 and 103 33 272.

The argumentation by the Examiner with respect to DE 102 37 446.5 is confusing and clarification is requested. Applicant is entitled to the filing date of DE 102 37 446.5 for the subject matter that is common to DE 102 37 446.5 and the subject matter of the instant application. The fact that DE 102 37 446.5 has tables or figure illustrations that have not been considered in the instant specification is immaterial. The contention by the Examiner that because material that has not been expressly disclosed in the instant specification is to be considered "new matter" is also incorrect because DE 102 37 446.5 is part of the instant application. It is therefore applicant's contention that the present application is entitled to the filing date of DE 102 37 446.5.

Claims 1-4, 7-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Pat. Publ. No. JP 11-302737 (hereinafter JP '737) in view of U.S. Pat. No. 6,544,356 to Katagiri et al. and U.S. Pat. No. 6,939,418 to Bilgen et al.

Claims 5-6, 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP '737 in view of Katagiri et al. and Bilgen et al, and further in view of Japanese Pat. Publ. No. JP 60-213246 (hereinafter JP '246).

Applicant respectfully disagrees with the Examiner's rejection of claim 1 for the following reasons:

With respect to JP '737, the Examiner readily acknowledged the absence of Ti, Nb, and V as ingredients in the described stainless steel. To bridge the absence of teaching, the Examiner applied Katagiri et al. which disclose a steel

sheet which contains, i.e., 0.08-0.40 wt. % Ti, 0.08-0.40 wt. % Nb, and 0.08-0.40 wt. % V. It is applicant's contention that an artisan would not combine Katagiri et al. with JP '737, as suggested by the Examiner, because these references involve different types of steel that have different composition and different purposes. While JP '737 discloses a steel which contains at least 8 % Cr and does not contain Ti, Nb, and V, Katagiri discloses a steel that requires the presence of aluminum, while Mo, W and B are optional (cf. col. 6, lines 9-26). Also, the JP '737 steel is used for a building structure, as a consequence of the corrosion resistance and weldability, whereas the Katagiri steel has a room temperature strength and high temperature strength for use as a frame member of a color picture tube (cf. abstract). Thus, the steels disclosed in JP '737 and Katagiri relate to completely different steel types that an artisan would not combine to produce the present invention. This is also evidenced by the chrome content between these prior art steels. In JP '737, the chrome content is 8-17 %, whereas Katagiri discloses a chrome content of 1.5-8.0 %.

Another essential difference between the JP '737 steel and the Katagiri steel is the required presence of Al in Katagiri.

It is also noted JP '737 and Katagiri are completely silent as to any spring characteristics. In particular, the high strength of the disclosed Katagiri steel, even at high temperature militate against the provision of a steel for use as spring element, as set forth in claim 1. The absence of any teaching with respect to spring characteristics, is bridged by the Examiner by applying the Bilgen et al. reference. Applicant respectfully disagrees with this approach and submits that an artisan would not apply the Bilgen et al. reference, as suggested by the Examiner, for the following reasons:

As noted above, the present invention, as set forth in claim 1, is directed to a spring element which is made from ferritic chromium steel having a specific composition, as recited in claim 1.

Bilgen et al., while disclosing a thermomechanical treatment of steel for torsionally-strained spring elements, are silent as to the composition of the steel

involved here. The only information given about the steel is set forth in col. 3, lines 13-16, where it is described that steel has a carbon content of 0.35% to 0.75% which is microalloyed with vanadium or another alloying element. That is essentially the extent of it, other than the designation 58SiCrV6 in col. 3, line 53 or col. 4, line 8). Taking into account that neither one of the steel compositions disclosed in JP '737 and Katagiri is applicable as material for a spring element, the fact that Bilgen et al. mentions spring elements would not motivate an artisan to make the combination, as suggested by the Examiner.

It is well established that the fact that individual elements of the present invention can be found in the prior art is not determinative as to the question of obviousness. (*In re Rouffet*, 47 USPQ2d, 1453, 1457 (Fed. Cir), stating "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.").

In summary, it is applicant's contention that the Examiner failed to make a prima facie case of obviousness. The approach taken by the Examiner to pick and choose among individual portions of various prior art references as a mosaic to recreate a facsimile of the claimed invention is ill-advised. The JP '737, Katagiri and Bilgen references were combined piecemeal without any suggestion or motivation for their combination and without regard to the purpose of applicant's invention. In particular, when steel alloys are involved, each alloying element has a quantitative and qualitative relevance. In other words, simply adding or subtracting an element will effectively change the alloy and thus alter also its characteristics. As noted above, the JP '737 steel is corrosion-resistant and thus weather-proof for building construction, whereas the Katagiri steel has high strength for use in color picture tubes. There is no correlation between these applications or purposes that would lead an artisan to make the combination, as suggested by the Examiner.

On the other hand, the present invention is directed to a spring element which serves a completely different purpose and which is based on a steel of characteristics that are very much different than the steels of JP '737 and Katagiri.

Reference is made in this context to paragraphs 13, 16-17, 25, and 35 of the instant specification.

For the reasons set forth above, it is applicant's contention that neither JP '737 nor Katagiri et al., nor Bilgen et al., nor any combination thereof teaches or suggests the features of the present invention, as recited in claim 1.

As for the rejection of the retained dependent claims, these claims depend on claim 1, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the claims on file. It is thus felt that no specific discussion thereof is necessary.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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